



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/996,338

11/27/2001

Jeffry J. Grainger

020313-000730US

1985

20350

7590

01/14/2005

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/996,338

Applicant(s)

GRAINGER, JEFFRY J.

Examiner

Jan Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-9, 11-13 and 19-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-9, 11-13 and 19-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on July 15, 2004, wherein:

Claims 4-9, 11-13, and 19-34 are currently pending;

Claims 1-3, 10 and 14-18 were cancelled previously;

Claims 4-9 and 19-20 have been amended;

Claims 21-34 have been added.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on July 15, 2004 is being considered by the examiner.

#### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 4-9, 11-13 and 19-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al (6,434,580) (hereinafter referred to as Takano) in view of Serbinis et al (US 6,584, 466) (hereinafter referred to as Serbinis).

Referring to Claim 19:

Takano discloses method of managing electronic documents related to patent applications, the method comprising:

allowing users to create a plurality of invention disclosures (invention reports, draft data for a specification) for each respective technology developer (inventor) for a

Art Unit: 3629

plurality of different and unrelated technology developers (inventors, (100, 200)) (col. 2, lines 1-10, col. 7, lines 54-63, Figs. 1-18);

receiving the invention disclosures from the users at a server system (300) over a network ((col. 5, lines 49-51 – these computers operate under programmed control and are connected to one another via a communication network such as the Internet) and storing the invention disclosures in one of a collection of electronic documents and data in a computer-readable memory coupled to the server system (310), wherein each document is associated with one of a patent application and assigned to at least one group (plurality of entities for registering plural pieces of invention report information – col. 7, line 54 thru col. 8, line 5;

storing additional electronic documents associated with some of the invention disclosures in the database (col. 13, line 45 thru col. 14, line 64);

maintaining and enforcing rights to electronic documents such that at least some users can access selected ones of the documents and such that users cannot access documents associated with unrelated technology developers (col. 8, lines 7-24 (displays only those [pieces or invention report information] satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department];

maintaining and enforcing rights to electronic documents such that at least some users have rights to view selected invention disclosures stored in the database and create and modify patent applications from the invention disclosures (col. 8, line 52 thru col. 9, line 8 – patent-application-filing persons are enabled to revise the draft data );

receiving created patent applications at the server system and storing the applications in the database (col. 8, lines 7-11 (upon registration of the draft data for the

Art Unit: 3629

specification for patent application and the pertinent piece of invention report information into the server computer), col. 16, lines 26-34 upon completion of final revision of the draft data by patent-application-filing persons, the draft uploading means (203) or the client computer (300) transmits the draft data and the piece of invention report information on the draft data to the server computer (300));

electronically receiving a request from a user to file a patent application, determining if the system has rights to file the patent application and causing the application to be file (col. 9, lines 1-8, col. 16, line 15 thru col. 18, line 18, Fig. 18 (1000).

Takano does not disclose databases for client systems associated with a plurality of patent firms, or wherein each user is assigned one or more roles that are associated with a set of permissions used to determine if a user can perform a particular operation on a particular document in the database; or wherein when a user generates a request to perform a particular operation, a determining whether a user may access the document and data, the level of access, determining the user's one or more roles associated with the set of permissions, and determining if the user can perform the operation requested on the document.

However, Serbinis teaches a method for Internet based document management wherein an electronic document may be stored on an Internet accessible server and accessed using a web browser, down loaded for review or manipulation and returned to the server for access by further users (collaborative file sharing service, col. 2, lines 15-20) and Serbinis also teaches an Internet-based document management system and method that permit users to access a plurality of services supported by a common

Art Unit: 3629

Internet-based database (col. 2, lines 52-57) The fact that one set of the plurality of users are patent law firms is non-functional descriptive material. This does not effect the document management method that permits users to collaboratively store, retrieve, modify and then return an electronic document to an Internet-based storage site. Therefore, it would have been obvious to one of ordinary skill in the art to have the users be a plurality of law firms since this does not functionally relate to the steps in the method claimed and thus does not patentably distinguish the claimed invention.

Serbinis also discloses wherein each user is assigned one or more roles that are associated with a set of permissions used to determine if a user can perform a particular operation on a particular document in the database (col. 2, lines 41-43 – provide needed access-control protocols so that specific users' privileges with respect to a document may be defined); or wherein when a user generates a request to perform a particular operation, a determining whether a user may access the document (col. 6, lines 35-46 - user's registered to access and use the DMS system, user group information, ie, document rights for the group) and data, the level of access, determining the user's one or more roles associated with the set of permissions, and determining if the user can perform the operation requested on the document (col. 3, lines 7-12 – provide needed access control protocols for example, so that specific users' privileges with respect to a document may be defined) (col. 11, lines 29-34) (col. 12, lines 24-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the disclosure of Takano the teachings of Serbinis so as to provide collaborative file sharing and workflow, document delivery and document

Art Unit: 3629

distribution and to provide needed access-control protocols so that specific users' privileges with respect to a document may be defined.

Referring to Claim 4:

Both Takano and Serbinis disclose a method wherein the users exchange documents with the server via the Internet (Takano col. 5, lines 45-51) (Serbinis col. 4, lines 30-63, Fig. 1A).

Referring to Claims 5-6:

It is unclear to the Examiner what the applicant is trying to claim here. It is old and well known to supply a correspondence mailing address when filing a patent application. It is unclear if the applicant is claiming an electronic address or a mailing address and if it is a mailing address, why?

Referring to Claim 7 and 9:

Takano and Serbinis disclose wherein documents are viewable over the Internet by some of the users as determined by an access management portion of the server (Takano col. 8, lines 15-19, col. 10, lines 20-21) (Serbinis col. 2, lines 41-43, col. 3, lines 10-13, col. 3, lines 32-41 – the server is programmed to perform a security function to verify or define a requestor's ability to access an electronic document, col.6, lines 19-46, col. 9, lines 19-33)

Referring to Claim 8:

Takano discloses a method in which there is a ready template data which make up a specification form for a patent application enabling the inventor to easily prepare a specification for the patent invention (col. 9, lines 46-51, Fig. 7)

Art Unit: 3629

Referring to Claims 11-13:

Takano a method wherein the patent application is filed in the patent office electronically (Fig. 18). It is old and well known to print the patent application on a printer and subsequently filed it with the patent office, or to include scanned versions of papers.

Referring to Claims 21 and 30:

Serbinis discloses a method wherein the electronic documents comprise word-processed document files, form-based document files and image files 9col. 8, lines 62-67).

Referring to Claims 22 and 31:

Serbinis discloses a method wherein each electronic document has document meta data associated with the document (col. 9, lines 19-32).

Referring to Claims 23 and 32:

Serbinis discloses a method wherein each document meta data further identifies the history of each document (col. 9, lines 19-32).

Referring to Claims 24 and 33:

Serbinis discloses a method wherein the user cannot perform operation on the electronic document if the user is excluded by the unit level access information (col. 3, lines 6-12 – it is common sense that if one does not have access information the user cannot perform an operation, col. 9, lines 19-32 – Users may be granted access only to retrieve and review a document, while others are granted access to retrieve and modify the document.)



Art Unit: 3629

Referring to Claims 25 and 34:

Serbinis discloses a method wherein the user can perform the operation on the document if the user is assigned permission and if the unit level access information permits the user to perform the operation (col. 3, lines 6-12, col. 6, lines 19-46, col. 9, lines 19-32) (See also Takano –col. 8, lines 14-18, col. 10, lines 20-23).

Referring to Claims 26 and 29:

Serbinis discloses a method wherein the plurality of groups are organized as a hierarchy such that a group in the plurality of groups may contain one or more other groups (col. 6, lines 19-46, col. 7, lines 16-27).

Referring to Claim 27:

Takano discloses a method of managing electronic documents related to a plurality of patent applications, the method comprising:

storing a plurality of collections of electronic documents and data on a computer-readable memory operatively coupled to a server system ( col. 5, lines 45-61), each collection being associated with one of the plurality of patent applications and each collection including data and one or more electronic documents related to its respective patent applications (col. 6, lines 5-15, col. 7, line 54 thru col. 8, line 5 – plurality of entities for registering plural pieces of invention report information) wherein each collection is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in the particular collection, (col. 8, lines 14-18 – displaying on a display unit a list of all pieces of invention report information registered in this table or only those satisfying specific conditions, e.g. only those pertaining to inventors belonging to a specific department) and wherein the plurality of

Art Unit: 3629

collections of electronic documents includes at least a first collection associated with a first patent application (col. 6, lines 5-15);

allowing a plurality of users to perform operations on electronic documents in the plurality of collections of electronic documents and data 9col. 8, lines 14-19, col. 10, lines 20-23),

receiving a request from a first user to perform an operation on an electronic document in the first collection (col. 8, line 7-26).

Takano does not disclose wherein each user is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in a particular collection of electronic documents and wherein each user is assigned one or more roles that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection or responsive to receiving the request, determining a first group to which the first user is assigned; determining a second group to which the document is assigned; determining one or more roles to which the first user is assigned and determining if the user can perform the operation on the electronic document in the first collection (document) based upon the first group to which the user is assigned, the second group to which the first collection is assigned and the set of permissions associated with the one or more roles to which the user is assigned.

However, Serbinis discloses wherein each user is assigned to at least one group that can be used in determining whether a user may access electronic documents and data in a particular collection of electronic documents (col. 6, lines 19-46 document's parent document group, col. 7, lines 16- 27 Fig. 3 is an illustrative *hierarchical* storage scheme

Art Unit: 3629

for storing electronic documents. Each user has access to one or more document groups, where each document group comprises a collection of document objects) and wherein each user is assigned one or more roles that are associated with a set of permissions that can be used in determining if a user can perform a particular operation on a particular electronic document in a collection or responsive to receiving the request (col. 6, lines 35-46 (users registered access, **user group information**, ie, information on the group of users that the user is a part of, **including document rights for the group**, col. 9 lines 19-32, and col. 11, lines 21-35 – **user's rights also may be implied by the service selected**) determining if the user can perform the operation on the electronic document in the first collection (document) based upon the first group to which the user is assigned (col. 6, lines 35-46 **User group information document rights for the group**, the second group to which the first collection is assigned (col. 6, lines 19-34 – **document rights**, **document group rights** and the set of permissions associated with the one or more roles to which the user is assigned (col. 9, lines 19-33 **-the Originator specifies the types of access that each authorized user is to receive. Some users may be granted access only to retrieve and review a document while others are granted access to retrieve and modify the document**)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the disclosure of Takano the teachings of Serbinis so as to provide collaborative file sharing and workflow, document delivery and document distribution and to provide needed access-control protocols so that specific users' privileges with respect to a document may be defined.

Referring to Claim 28:

Art Unit: 3629

Serbinis discloses a method wherein the first collection associated with the first patent application (document) includes unit level access information and wherein the step of determining if the user can perform the operation on the electronic document is based upon the level access information (col. 2, lines 41-43, col. 3, lines 11-13, col. 6, lines 19-43, col. 9, lines 19-31).

Referring to Claim 20:

Takano discloses a system for managing intellectual property, the system comprising:

- a processor (inherent in computer system manipulating data);
- a computer readable memory coupled to the processor (col. 5, lines 45-51);
- an invention disclosure creation component (col. 5, lines 55-61);
- a patent application creation component (Fig. 18 (500));
- a document management and access component (col. 7, line 51 thru col. 8, line 24);
- a patent application filing component (Fig. 18)

Although Takano discloses that the system is connected to a plurality of inventors, Takano does not disclose that the system is disclosed to a plurality of patent firm users with associated access rights. However, Serbinis discloses a document management system wherein the server is programmed to provide for a plurality of services supported by a common database and document store, including storage and retrieval services (a collaborative file sharing service programmed with a security function) (Fig. 1B, Figs. 2, 3). The fact that one set of the plurality of users are patent law firms is non-functional descriptive material. This does not effect the document

Art Unit: 3629

management system that permits users to collaboratively store, retrieve, modify and then return an electronic document to an Internet-based storage site. Therefore, it would have been obvious to one of ordinary skill in the art to have the users be a plurality of law firms since this does not functionally relate to the steps in the method claimed and thus does not patentably distinguish the claimed invention.

Takano does not disclose a document management and access component that maintains and enforces rights such that in response to receiving a request from a user to perform an operation determining a first group to which the first user is assigned; determining a second group to which the document is assigned; determining one or more roles to which the first user is assigned and determining if the user can perform the operation on the electronic document in the first collection (document) based upon the first group to which the user is assigned, the second group to which the first collection is assigned and the set of permissions associated with the one or more roles to which the user is assigned.

However, Serbinis discloses responsive to receiving the request (col. 6, lines 35-46 (users registered access, **user group information**, ie, information on the group of users that the user is a part of, **including document rights for the group**, col. 9 lines 19-32, and col. 11, lines 21-35 – **user's rights also may be implied by the service selected**) determining if the user can perform the operation on the electronic document in the first collection (document) based upon the first group to which the user is assigned (col. 6, lines 35-46 **User group information document rights for the group**, the second group to which the first collection is assigned (col. 6, lines 19-34 – **document rights**, **document group rights** and the set of permissions associated with the one or more roles

Art Unit: 3629

to which the user is assigned (col. 9, lines 19-33 **-the Originator specifies the types of access that each authorized user is to receive. Some users may be granted access only to retrieve and review a document while others are granted access to retrieve and modify the document)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the disclosure of Takano the teachings of Serbinis so as to provide collaborative file sharing and workflow, document delivery and document distribution and to provide needed access-control protocols so that specific users' privileges with respect to a document may be defined.

***Response to Arguments***

4. Applicant's arguments filed on July 15, 2004 have been fully considered but they are not persuasive.

First, the applicant argues on page 21 of the response that:

Takano et al. is directed to a system for preparing patent applications for a single entity or company. The system in Takano allows for inventors of the single company to create invention disclosures and forward the disclosures to an appropriate patent attorney for preparation of a patent application. See e.g., col. 5, line 52 to col. 6, line 15. The inventor and attorney interact with a common server computer over a network connection such as the Internet. Col. 5, lines 49-51. There is no disclosure or suggestion within Takano et al. that the system can be used to create invention disclosures and patent applications and track other related electronic documents associated with the same for multiple, unrelated companies or technology developers. Applicant further argues that there is no disclosure in Takano, of maintaining and enforcing access rights among multiple law firms to patent application data stored in a common repository.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., unrelated companies) were not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, claims must be given their broadest reasonable interpretation consistent with the supporting description. Therefore, interpreting the term unrelated

Art Unit: 3629

technology developers could define inventors which are in different departments within a company.

Takano and Serbinis discloses a method for Internet-based document management wherein an electronic document may be stored on an Internet-accessible server and accessed using a web browser, downloaded for review or manipulation and returned to the server for access by further users. The fact that one set of the plurality of users are patent law firms or unrelated companies is non-functional descriptive material. This does not effect the document management method that permits users to collaboratively store, retrieve, modify and then return an electronic document to an Internet-based storage site.

The applicant argues on page 23 of the response that Takano does not teach or suggest the method of maintaining and enforcing rights to access electronic documents and data as recited in Claim 19. Claim 19 has been extensively amended by the applicant to incorporate group level access, user roles and unit level access in making a determination as to whether or not a particular user can perform a particular operation.

The Examiner has applied Serbinis as prior art to teach the new disclosure. Applicant is directed the Examiners discussion in the above rejections. It is the Examiners position that Serbinis does disclose three different levels of data (a group level to which the user is assigned (information on a group of users that the user is a part of including document rights for the group, col. 6, lines 34-46), a group to which the document is assigned (document groups with document rights, and document group rights (col. 6, lines 19-34, col. 7, lines 16-27 – a hierarchical storage scheme), one or more roles associated with a set of permissions (col. 9, lines 19-33 – A list of Authorized Users who may access the document, the type of access that each user receives and meta



Art Unit: 3629

data concerning the document, and col. 11, line 21 thru col. 12, line 43 (The Authorized User's rights also may be implied by the service selected), and unit level access for particular collection of documents) which are used to make a determination whether a user can perform a particular operation (access- control protocols so that specified users' privileges with respect to a document may be define (col. 4, lines 7-12).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

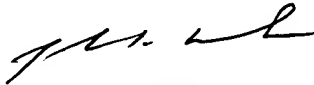
Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm

  
**JOHN G. WEISS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600